REMARKS

This is in response to an Office Action that was mailed on October 7, 2008. Claims 1-4, 6, 7, 9, 10, 14-16, 18, 19 and 21 were pending in that action. All claims except claim 21 were rejected. With the present response, claims 1, 16 and 19 are amended. Claims 6, 9, 10, 14, 15 and 18 are cancelled. The remaining claims are unchanged.

Beginning on page 2 of the Office Action, the Examiner rejected claims 1-4, 6, 7, 9, 10, 14-16, 18, 19 and 20 under 35 U.S.C. §101 for allegedly being directed to non-statutory subject matter. Applicant respectfully disagrees. Applicant respectfully contends that all of the claims in the present case are directed to statutory subject matter. In particular, Applicant respectfully contends that the claims satisfy the requirements of 35 U.S.C. §101 as stated in the recent Bilsky case. In re Bilsky, no. 2007-1130 (Fed Cir. October 30, 2008). In citing sections of the Bilsky case below, Applicant cites to the page numbers listed at the bottom of the pages from the copy of the case on the Court's website (http://www.cafc.uscourts.gov/opinions/07-1130.pdf).

In Bilsky, the Court stated that "[a] claimed process is surely patent-eligible under §101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing". Id. at 10. Applicant respectfully contends that the claims in the present case satisfy both of these tests.

In regard to the first test, Applicant's claims are clearly tied to a particular machine or apparatus. The claims are each tied to a computing device. For example, independent claims 1, 16 and 19 each recite in part "[a] computer-implemented method."

On page 2 of the Office Action, the Examiner seems to acknowledge that the claims are tied to a computer. However, the Examiner seems to suggest that the limitations in the body of the claim need to positively recite physical hardware components. Applicant respectfully disagrees. Applicant respectfully contends that the Examiner's requirements for satisfying §101 are inconsistent with the requirements stated by the Bilsky Court. In the Bilsky case, the Court stated that:

"Thus, the proper inquiry under §101 is not whether the process claim

recites sufficient 'physical steps' but rather whether the claim meets the machine-or-transformation test. As a result, even a claim that recites 'physical steps' but neither recites a particular machine or appartus, nor transforms any article into a different state or thing, is not drawn to patent-eligible subject matter. <u>Conversely, a claim that purported lacks any 'physical steps' but it still tied to a machine or achieves an eligible trans-formation passes muster under §101."</u> <u>Id</u> at 23 (emphasis added).

In rejecting the claims, the Examiner is essentially requiring "physical steps" that the <u>Bilsky</u> Court stated were not needed. Instead of the "physical step" requirements, the Court advocated a flexible facts-based and policy-based determination. The test focused on the whether the tied to the computer meanfully reduced the scope of the claim. For example, the Court stated that a claim's tied to a computer would not be sufficient to reduce the preemptive footprint of the claim if "all uses of the algorithm were still covered by the claim." <u>Id</u> at 13.

In the present case, the claims are directed to very specific computer-based applications. The claims are not preempting any non-computer based applications of the associated algorithms. The claims are not even preempting all of the computer-based applications of the associated algorithms. The claims are clearly tied to a machine and are narrowly drawn to specific fields and to specific applications within those fields. Applicant respectfully contends that this satisfies the first of the two tests stated by the Court.

In regard to the second test, the Court stated that the test of transforming a particular article into a different state or thing would not be satisfied if a "claim did not specify any particular type or nature of data; nor did it specify how or from where the data was obtained or what the data represented". <u>Id</u> at 25. The Court stated that the test would be satisfied if more specific types of data were transformed such as "said data is X-ray attenuation data produced in a two dimensional field by a computed tomography scanner." <u>Id</u> at 26. The Court did not want claims to preempt the use of algorithms across all fields of endeavor by preempting the use of the algorithms with all types of data.

In the present case, the types of data and underlying information are very specific. The claims are not directed at preempting all uses of the associated algorithms to all types of data. This type of narrow claim scope is what the Court stated was allowable. Because of the specific data, information, and associated transformations recited in the claims, Applicant respectfully contends that the claims satisfy the second <u>Bilsky</u> test.

In light of the above remarks, Applicant respectfully contends that his claims satisfy the requirements under 35 U.S.C. §101 as stated by the Court in <u>Bilsky</u>. Additionally, Applicant would like to point out that although the Applicant contends that his claims satisfy both of the tests articulated in <u>Bilsky</u>, only one of the two tests needs to be satisfied in order to meet the standards of §101. Applicant respectfully requests that the §101 rejections be withdrawn.

Finally, while Applicant does contend that his claims, without amendment, satisfy the requirements of §101 as stated by the Court in <u>Bilsky</u>, Applicant has amended the claims herewith to include a processor associated with a computing device that executes at least one of the claimed method elements.

Beginning on page 3 of the Office Action, the Examiner rejected claims 1-4, 6, 7, 9, 10, 14-16, 18 and 19-20 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2002/0078069, which is attributed to Moore, in view of U.S. Patent No. 5,995,921, which is attributed to Richards. For reasons that will be discussed in detail below, it is respectfully submitted that the cited references fail to teach or suggest the elements of the presently pending claims, regardless of whether the references are considered independently or in combination.

Independent claims 1, 16 and 19 each include, to some extent, the concept of <u>a task identifier indicative of a help-related task described in the content of a file to which the identifier is assigned</u> (emphasis added). It is respectfully submitted that this feature is neither taught nor suggested by the cited references considered independently or in combination. The Examiner argues that the Moore reference (especially paragraphs 0031, 0034, 0035, and FIGS. 1 and 4A) discloses all the technical features of claim 1 except for the noted task identifier, which

is allegedly disclosed by the Richards reference at FIG. 2. Applicant respectfully requests that the Examiner reconsider this analysis in light of the following comments.

The cited Moore reference seeks to provide <u>automatic file naming and manipulation</u> within a data processing system, and more specifically to provide automatic file naming and manipulation for documents generated utilizing a standard document structure such as a template, form or style sheet. When a new document is created utilizing the document-defining structure, the file naming attribute is employed to automatically generate a file name for a discreet file into which the new document may be saved (see page 1, paragraphs 0010-0012 of the Moore reference).

In contrast, embodiments of the present invention pertain to a structured discipline for the efficient creation and reduced-overhead maintenance of large sets of help topic descriptors. More specifically, embodiments pertain to a "structured task name" process that <u>imposes a discipline on the naming of tasks such that they can be conveniently stored, displayed, checked, edited, localized and the like.</u> Implementation of a grammar as described in Applicant's specifically as originally filed makes it easy to sort, view, compare, edit, refine and diagnose a list of tasks that have been identified accordingly. It is quite apparent that the teachings of the Moore reference have little or nothing to do with the methods claimed in the present case.

Contrary to the Examiner's assertions in the Office Action, the cited Moore reference fails to teach or suggest a task identifier indicative of a help-related task described in the content of a file to which the identifier is assigned. For example, independent claim 1 includes "providing a user with a limited set of word selections that can be assigned to represent a first of a plurality of elements that together form the task identifier." The cited Moore reference does not teach or suggest this claim element because it does not teach or suggest a task identifier indicative of a help-related task described in the content of the file.

Instead, the Examiner attempts to argue that the claimed task identifier is instead disclosed by the Richards reference at FIG. 2 because the method of the Richards reference utilizes a help file to describe the tasks in the file that are associated with help. The Richards reference discloses a data processing system having a natural language <u>help interface</u> in which a

user can query the system using a natural language. Thus, it is true that the Richards reference and claimed embodiments of the present invention have something to do with help files.

However, though the Richards reference discloses help files 228 in FIG. 2, there is absolutely no teaching or suggestion in the Richards reference of a "task identifier" as claimed. The task identifier is missing from both of the cited references. The Examiner has provided no guidance as to how the Richards and Moore references could be combined in order to come up with the elements of independent claims 1, 16 and 19.

Accordingly, independent claim 1 differs from the cited Moore reference at least in that the claimed "task identifier" is missing from the cited reference. The Richards reference does not remedy the inability of the Moore reference to teach or suggest these features of independent claim 1. Accordingly, it is respectfully submitted that independent claim 1 and its associated dependent claims are allowable for at least these reasons. Further, independent claims 16 and 19, as well as their dependent claims, are also believed to be allowable at least because these claims similarly recite a "task identifier."

All this being said, in the spirit of cooperation, Applicant has proposed a compromise by relocating the elements of dependent claim 6 into independent claim 1. Thus, independent claim 1 is now limited to assigning the claimed file to more than one taxonomic category based on the claim selection received from a user and indicative of a particular word selection from a limited set of word selections. In response to this element, the Examiner simply points to the cited Moore reference at paragraph 0039. However, there is absolutely nothing in the cited paragraph that has anything to do with assigning multiple taxonomic categories based on the selection of a particular word from a limited set of word selections. The reference shows selecting a word, and may show assigning a category based on that word selection, but the reference does not show assigning multiple taxonomic categories based on the selection of a word from a limited set. For this additional reason, it is respectfully submitted that independent claim 1 and its associated dependent claims are allowable over the cited art of record.

Further, also in the spirit of cooperation, Applicant has amended independent claim 16 such that it now includes the elements of a now cancelled dependent claim 18. Thus,

independent claim 16 is limited to assigning a first taxonomic category to a first word selection from a limited set of word selections. In rejecting this claim, the Examiner points to paragraph 0031 of the cited Moore reference. This paragraph simply describes selecting a word from a limited set of selections. There is absolutely no teaching or suggestion of assigning a taxonomic category as claimed. For this additional reason, it is respectfully submitted that independent claim 16 is in allowable form.

Finally, Applicant respectfully points out that the Examiner failed to reject dependent claim 21, which is dependent upon independent claim 19. In fact, the elements of claim 21 are neither taught nor suggested in any of the cited references. Given that claim 21 was not rejected, Applicant respectfully requests allowance of that claim. Applicant respectfully points out that no rejection should be asserted against claim 21 after final without giving Applicant opportunity to respond to such a rejection.

In summary, it is respectfully submitted that claims 1-4, 7, 16, 19 and 21 are in condition for allowance. Reconsideration and favorable action are respectfully solicited.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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